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Attorneys for Plaintiff
EL BURRO, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

EL BURRO, INC, a California
corporation,

Plaintiff,

v.

KNUCKLE SANDWICH LLC, a
California limited liability company,

Defendant.

Case No. 3:23-cv-3782

COMPLAINT

Plaintiff EL BURRO, INC. (“Plaintiff”) files this Complaint and complains and alleges as follows against KNUCKLE SANDWICH LLC (“Defendant”).

INTRODUCTION

1. This is an action under Section 21(b)(1) of the Lanham Act, 15 U.S.C. § 1071(b)(1), seeking de novo judicial review of a final decision of the Trademark Trial and Appeal Board (“TTAB”) of the United States Patent and Trademark

1 Office.

2 2. By a decision dated May 26, the TTAB denied a cancellation petition
3 brought by Plaintiff to cancel United States Trademark Registration No. 4868002
4 owned by Defendant for the term El Burro Borracho.

5 3. The decision by the TTAB denying Plaintiff's cancellation petition was
6 incorrect and not supported either by the law or the evidence in this matter.

7 4. Accordingly, by this action, Plaintiff seeks an order from this Court
8 reversing and vacating the referenced TTAB order, and an order directing the
9 United States Patent and Trademark Office to cancel the Subject Registration.

10 JURISDICTION AND VENUE

11 5. This Court has subject matter jurisdiction in this matter pursuant to
12 section 21 of the Lanham Act, 15 U.S.C. § 1071(b). This Court also has subject
13 matter jurisdiction pursuant to 15 U.S.C. § 1331.

14 6. Venue is proper in this district pursuant to 15 U.S.C. § 1071(b)(4) and
15 28 U.S.C. §§ 1391(b) and (c).

16 THE PARTIES

17 7. Plaintiff EL BURRO, INC. is a corporation organized and existing
18 under the laws of the State of California with its principal place of business in
19 Carson, California.

20 8. Plaintiff operates Mexican food eateries under the federally-registered
21 trademark "EL BURRO" and has built a prominent reputation amongst customers
22 seeking exceptional Mexican food.

23 9. Defendant KNUCKLE SANDWICH LLC is a limited liability
24 company organized under the laws of the State of California with its principal place
25 of business in Santa Rosa, California.

26 GENERAL ALLEGATIONS


27 10. Since at least 2011, Plaintiff has been creating, marketing, promoting
28 and selling food and services in Mexican eateries under its EL BURRO® family of

1 trademarks (the “El Burro Marks”).

2 11. Through the promotion of its restaurant services under its El Burro
3 Marks, Plaintiff has built a prominent reputation amongst customers seeking
4 exceptional Mexican food.

5 12. Furthermore, as a result of Plaintiff’s extensive advertisement and
6 promotion of the El Burro Marks, it has developed enormously valuable goodwill.

7 13. Plaintiff owns a family of trademarks featuring the term “El Burro,”
8 including the following registrations with the U.S. Patent and Trademark Office:

Mark	Reg. No.	First Use	Registered	Class
	4140047	2/11/2011	5/8/2012	43
EL BURRO	4151153	2/11/2011	5/29/2012	43

16 14. The foregoing registrations are incontestable and therefore constitute
17 conclusive evidence of Plaintiff’s ownership of and exclusive rights to use the El
18 Burro Marks in connection with the services recited in the referenced registrations.

19 15. Defendant is the owner of Registration No. 4,868,002 for the mark EL
20 BURRO BORRACHO (the “Subject Mark”) for restaurants in International Class
21 43 which issued on December 8, 2015 (the “Subject Registration”).

22 16. Defendant’s purported first use of the Subject Mark is December 31,
23 2014.

24 17. Defendant is operating Mexican food eateries and is marketing,
25 promoting and offering restaurant services under the Subject Mark.

26 18. Plaintiff and Defendant are competitors in the same field or industry in
27 that they both use their respective trademarks for Mexican food eateries.
28

COUNT TWO

(Request For Declaratory Judgment Pursuant To 28 U.S.C. §§ 2201 And 2202)

30. Plaintiff repeats and realleges each and every allegation in paragraphs 1 through 29 as though fully set forth herein.

31. Plaintiff challenges and seeks cancellation of the Subject Registration Defendant's Subject Mark is confusingly similar to Petitioner's El Burro Marks so as to be likely, when used in connection with Defendant's restaurant services, to cause confusion, to cause reverse confusion, to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

32. Plaintiff is informed and believes and upon that basis alleges that Defendant denies Plaintiff's position.

33. Consequently, there exists an actual controversy among the parties about whether the Subject Registration should be cancelled, with respect to which Plaintiff requests a declaratory judgment pursuant to 28 U.S.C. § 2201.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff respectfully requests the Court enter judgment as follows:

- A. Reversing the Subject Decision;
- B. Ordering that the TTAB enter an order cancelling the Subject Registration; and
- C. Awarding Plaintiff such other relief as the Court may deem just and proper.

Dated: July 28, 2023

THE AFFINITY LAW GROUP

By: 

Gregory P. Goonar
Attorneys for Plaintiff